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Attorney's Docket No. 019519-287

Patent

AF / 1774

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	Mailstop: AF
)	
Koichi KAWAMURA)	Group Art Unit: 1774
)	
Application No.: 09/764,128)	Examiner: L. Ferguson
)	
Filed: January 19, 2001)	Confirmation No.: 8099
)	
For: DIRECT IMAGING LITHOGRAPHIC)	
PRINTING PLATE)	

REQUEST FOR RECONSIDERATION

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

In response to the Official Action dated August 8, 2003, reconsideration is respectfully requested in light of the remarks which follow.

In the Official Action, the Examiner rejected all of the claims under 35 U.S.C. §103(a) based on the combinations of either of the Tashiro et al. patents, U.S. Patent No. 5,945,240 or United States Patent No. 5,939,228, in view of Bhambra et al., United States Patent No. 6,105,500. The Examiner conceded that the Tashiro et al. patents did not disclose a printing plate with a direct chemical bond from the layer having hydrophilicity to the support, but relied on Bhambra et al. to show this aspect of the claimed invention.

In analyzing the propriety of any rejection of the claims, one must always consider the specific claim language. Claim 1 recites, *inter alia*, a polymer compound which has a direct chemical bond to the support surface and has hydrophilic functional groups capable of forming chelates together with metal ions and further defines the polymer compound as

being a hydrophilic functional group-containing straight-chain polymer compound having a direct chemical bond to the support surface at its molecular end.

Bhambra et al. in no way discloses or teaches this specifically defined polymer compound as having a direct chemical bond to the support surface at its molecular end. The patent does not disclose any type of polymer compound which is capable of forming metal chelates together with metal ions and does not disclose any type of polymer compound that is a hydrophilic functional group-containing straight-chain polymer compound. To the contrary, Bhambra et al. in the passage in column 7 relied on by the Examiner in the Action describes a silicate that is bonded to the substrate. As is well known in the art, the silicon atom of the silicate is tetrafunctional and therefore a silicate is not a straight-chain polymer, much less one that is capable of forming metal chelates together with metal ions. In addition, one cannot selectively cull teachings from the disclosure of Bhambra et al. The patent does not teach any polymer compound, but instead identifies silicate materials bonded to the surface. Thus, even if there exists a proper basis for the proposed combination of patents (which applicant does not concede exists), the silicate of Bhambra et al. in the layer of the Tashiro et al. patents would still not result in the invention defined in the claims of record.¹

¹ For instance, in In re Wesslau, 147 USPQ 391 (CCPA 1965), the court cautioned: "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art."

Accordingly, since the hypothetical combination of the Tashiro et al. patents with Bhambra et al. would not result in the presently claimed invention, applicant respectfully requests reconsideration and allowance of the present application.

Should the Examiner wish to discuss any aspect of the present application, he is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,

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